

09/ 932353

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PATENT, TRADEMARK,
 COPYRIGHT AND RELATED
 INTELLECTUAL PROPERTY LAW



May 11, 2005

Mail Stop Certificate of Corrections Branch
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Re: U.S. Patent No.: 6,869,391
 Issued: March 22, 2005
 Inventor: Herbert Bächler et al.
 Our Docket: 33891

Certificate
MAY 18 2005
of Correction

Sir:

A Certificate of Correction under 35 U.S.C. 254 is hereby requested to correct Patent Office printing errors in the above-identified patent. Enclosed herewith is a proposed Certificate of Correction (Form No. PTO-1050) for consideration along with appropriate documentation supporting the request for correction.

It is requested that the Certificate of Correction be completed and mailed at an early date to the undersigned attorney of record. The proposed corrections are obvious ones and do not in any way change the sense of the application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Michael W. Garvey

Name of Attorney for Applicant(s)

Signature of Attorney

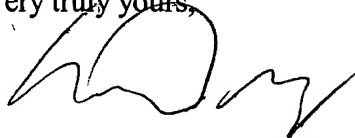
Date

MAY 20 2005

U.S. Patent No.: 6,869,391
Issued: March 22, 2005
Atty. Docket No.: 33891
Page 2 of 2

We understand that a check is not required since the errors were on the part of the Patent and Trademark Office in printing the patent.

Very truly yours,

A handwritten signature in black ink, appearing to read 'M. Garvey', with a large loop at the beginning and a checkmark-like flourish at the end.

Michael W. Garvey, Reg. No. 35878

JJS:alw
Enclosures

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 6,869,391
DATED : March 22, 2005
INVENTOR(S) : Herbert Bächler et al.

PAGE 1 OF 1

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

IN THE CLAIMS:

Claim 28, Column 4, line 14, after "said coil is placed", please insert --in--.

MAILING ADDRESS OF SENDER:

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PATENT NO. 6,869,391

No. of additional copies

⇒ 0

MAY 20 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/932,353 **Confirmation No.:** 4874
Applicant : Herbert Bachler
Filed : August 17, 2001
GAU : 3736
Examiner: Jonathan M. Foreman
Title : IMPLANTABLE HEARING AID
Docket No. : TSW-33891
Customer No.: 00116

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT "D"

Sir:

This amendment is filed in response to the Office Action dated April 19, 2004. The three month response period expired on July 19, 2004. Applicant's attorney hereby requests a one month extension of time to extend the response period through August 19, 2004. By this amendment, thirty-five (35) claims remain pending in this application including nine (9) independent claims. A check in the amount of \$540 is enclosed to cover the \$430 fee for five (5) independent claims not previously paid for and the \$110 one month extension of time filing fee.

In response to the Office action of April 19, 2004, paper no. 18, and the personal interview conducted on July 15, 2004 (paper no. 19), please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 9 of this paper.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Robert F. Bodi

Name of Attorney for Applicant(s)

August 2, 2004

Date

Signature of Attorney

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1 1-27 (canceled).

1 28. (previously presented) A method for enhancing
2 auditory capacity by amplifying a natural movement of a
3 vibrating ossicle tract, said method comprising the steps of:
4 converting an acoustic signal into an electrical signal;
5 and
6 converting said electrical signal into a mechanical
7 oscillation of a coil ^{positioned} [adapted for positioning] in a
8 middle ear, wherein said converting said electrical
9 signal into said mechanical oscillation of said coil
10 utilizes a permanent magnet separate from said coil
11 [adapted for being] solidly attached on a promontory.

1 29. (previously presented) The method of claim 28,
2 wherein said coil is adapted for placing in an area of an
3 ossicle chain.

1 X 30. (currently amended) The An implantable hearing device
2 ~~of one of claims 13-16~~ comprising:
3 at least one permanent magnet adapted for being solidly
4 attached on a promontory in the area of the middle
5 ear; and
6 at least one coil, separate from said permanent magnet,
7 adapted for placing in the area of the middle ear,
8 said hearing device for implementing a method
9 comprising the steps of:
10 converting an acoustic signal into an electrical signal;
11 and

12 converting said electrical signal into a mechanical
13 oscillation of a coil adapted for positioning in a
14 middle ear.

1 31. (currently amended) ~~The~~ An implantable hearing device
2 ~~of claim 26~~ comprising:
3 at least one permanent magnet adapted for being solidly
4 adjustably attached on a promontory in the area of
5 the middle ear; and
6 at least one coil, separate from said permanent magnet,
7 adapted for placing in the area of the middle ear,
8 said hearing device for implementing a method
9 comprising the steps of:
10 converting an acoustic signal into an electrical signal;
11 and
12 converting said electrical signal into a mechanical
13 oscillation of a coil adapted for positioning in a
14 middle ear.

1 32. (currently amended) ~~The~~ An implantable hearing device
2 ~~of claim 27~~ comprising:
3 at least one permanent magnet adapted for being solidly
4 attached on a promontory, in an adjustable fashion,
5 in the area of the middle ear; and
6 at least one coil, separate from said permanent magnet,
7 adapted for placing in the area of the middle ear,
8 wherein an air-gap between said permanent magnet and
9 said coil can be adjusted by post-implantation
10 adjustment of said magnet, said hearing device for
11 implementing a method comprising the steps of:
12 converting an acoustic signal into an electrical signal;
13 and

14 converting said electrical signal into a mechanical
15 oscillation of a coil adapted for positioning in a
16 middle ear.

1 33. (previously presented) The method of claim 28,
2 wherein said coil is adapted for placing at the tympanic
3 membrane.

1 34-44 (canceled).

1 45. (new) The method of claim 28, wherein said coil¹⁵
2 placed behind a tympanic membrane.

1 46. (new) A method for enhancing auditory capacity,
2 comprising the steps of:
3 converting an acoustic signal into an electrical signal;
4 and
5 converting said electrical signal into a mechanical
6 oscillation of a coil positioned in a middle ear by
7 utilizing a permanent magnet, separate from said
8 coil, solely attached to a promontory.

1 47. (new) The method of claim 46, wherein said coil is
2 positioned behind a tympanic membrane.

1 48. (new) The method of claim 46, wherein said coil is
2 positioned at a tympanic membrane.

1 49. (new) The method of claim 46, wherein said coil is
2 positioned in an area of an ossicle chain¹

1 50. (new) The method of claim 46, wherein said permanent
2 magnet is removeably attached to the promontory.

1 51. (new) The method of claim 46, wherein said permanent

2 magnet is attached on the promontory in an adjustable fashion.

1 52. (new) The method of claim 51, wherein an air-gap
2 between said permanent magnet and said coil can be adjusted by
3 post-implantation adjustment of said magnet.

1 53. (new) A method for enhancing auditory capacity,
2 comprising the steps of:
3 placing a coil in the area of a component of the middle
4 ear;
5 attaching a magnet, separate from said coil, solely to a
6 promontory; and
7 converting an electrical signal into a mechanical
8 oscillation of said coil, wherein said mechanical
9 oscillation is transmitted to said component of the
10 middle ear.

1 54. (new) The method of claim 53, wherein said coil is
2 placed behind a tympanic membrane.

1 55. (new) The method of claim 53, wherein said coil is
2 placed at a tympanic membrane.

1 56. (new) The method of claim 53, wherein said coil is
2 placed in an area of an ossicle chain

1 57. (new) The method of claim 53, wherein said permanent
2 magnet is removeably attached to the promontory.

1 58. (new) The method of claim 53, wherein said permanent
2 magnet is attached on the promontory in an adjustable fashion.

1 59. (new) The method of claim 58, wherein an air-gap
2 between said permanent magnet and said coil can be adjusted by

3 post-implantation adjustment of said magnet.

4 60. (new) A method for enhancing auditory capacity,
5 comprising the steps of:
6 placing a coil in the area of a component of the middle
7 ear;
8 solidly attaching a magnet, separate from said coil, on a
9 promontory; and
10 converting an electrical signal into a mechanical
11 oscillation of said coil, thereby providing said
12 mechanical oscillation to said component of the
13 middle ear.

1 61. (new) The method of claim 60, wherein said coil is
2 placed behind a tympanic membrane.

1 62. (new) The method of claim 60, wherein said coil is
2 placed at a tympanic membrane.

1 63. (new) The method of claim 60, wherein said coil is
2 placed in an area of an ossicle chain

1 64. (new) The method of claim 60, wherein said permanent
2 magnet is attached on the promontory in an adjustable fashion.

1 65. (new) The method of claim 64, wherein an air-gap
2 between said permanent magnet and said coil can be adjusted by
3 post-implantation adjustment of said magnet.

1 66. (new) A method for enhancing auditory capacity,
2 comprising the steps of:
3 attaching a coil to a component of the middle ear;

4 attaching a magnet, separate from said coil, on a
5 promontory, such that said magnet is solely attached
6 to said promontory; and
7 converting an electrical signal into a mechanical
8 oscillation of said coil for providing said
9 mechanical oscillation to said component of the
10 middle ear.

1 67. (new) The method of claim 66, wherein said coil is
2 placed behind a tympanic membrane.

1 68. (new) The method of claim 66, wherein said coil is
2 placed at a tympanic membrane.

1 ~~69.~~ 69. (new) The method of claim 66, wherein said coil is
2 placed ~~in~~ an area of an ossicle chain

→ original claim 66 has been
re-numbered as claim 25.

1 70. (new) The method of claim 66, wherein said permanent
2 magnet is removeably attached to the promontory.

1 71. (new) The method of claim 66, wherein said permanent
2 magnet is attached on the promontory in an adjustable fashion.

1 72. (new) The method of claim 71, wherein an air-gap
2 between said permanent magnet and said coil can be adjusted by
3 post-implantation adjustment of said magnet.

1 73. (new) A method for enhancing auditory capacity,
2 comprising the steps of:
3 attaching a coil to an eardrum or to a component of the
4 ossicle tract;
5 solidly attaching a magnet, separate from said coil,
6 solely on a promontory, such that said magnet is

★ original claim 69 has been re-numbered
as claim 28.

7 attached to said promontory in an adjustable
8 fashion; and
9 converting an electrical signal into a mechanical
10 oscillation of said coil to transmit said
11 oscillation to said eardrum or to said component of
12 said ossicle tract.

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on July 15, 2004 with the Examiner and the Examiner's supervisor. The application has been carefully reviewed in light of the Office action and the interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 28-32 remain in this application. Claims 28-33 have been allowed by the Examiner, and claims 30-32 have been amended merely to incorporate elements from currently canceled claims upon which they depended. Claims 1-27 and 34-44 have been canceled. Claims 45-73 have been added without adding any new matter.

Claims 13, 14, 19, 21, and 23-26, were rejected under 35 U.S.C. §102(b) as being anticipated by Hough *et al.* (U.S. 4,606,329). Claims 13-16, 21, 22, 26, 36-38, 40-42, and 44 were rejected under 35 U.S.C. §102(b) as being anticipated by Perkins (U.S. 6,084,975). Claims 39 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkins. For the following reasons, the rejections are respectfully traversed.

Claims 13-16, 19, 21-26 36-39, 40-43, and 44 have all been canceled, making their rejections moot. New independent claims directed to a method of enhancing auditory capacity have been added each having a limitation of a magnet being "solidly attached" or a limitation of the magnet being "attached solely" to a promontory. As discussed at the personal interview, none of the references teach that a magnet is solidly attached or solely attached to a promontory. Hence, the new independent claims are each patentable over the references.

The remaining new claims, which depend, either directly or indirectly, on one of the independent claims, are thus patentable for the same reasons (as well as for the limitations contained therein).

In consideration of the foregoing analysis, it is respectfully submitted that the

Appl. No. 09/932,353
Amdt. Dated August 2, 2004
Reply to Office action of April 19, 2004

present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33891.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

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August 2, 2004